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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,794	01/17/2002	Andrew Alan Farmer	CLON-069	7438
41064	7590	11/30/2004	EXAMINER	
BOZICEVIC, FIELD & FRANCIS (BD BIOSCIENCES) 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			MARVICH, MARIA	
		ART UNIT	PAPER NUMBER	
		1636		

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/055,794	FARMER, ANDREW ALAN
	Examiner	Art Unit
	Maria B Marvich, PhD	1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 July 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-11 and 21-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2-11 and 21-28 is/are rejected.
 7) Claim(s) 29 and 30 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 July 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/03, 1/22/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to a response to an amendment filed 7/8/04. Claims 1, 12-20 and 31-37 have been cancelled. Claims 2, 7-11, 21 and 24 have been amended. Claims 2-11 and 21-30 are pending in the application. Furthermore, this office action is in response to a Petition to Withdraw Holding of Potential Abandonment under 37 CFR 1.181 filed 7/8/04. Applicants argue that a response to the Office Action mailed 7/18/02 was timely filed on 9/19/02 as evidenced by a Certificate of Mailing accompanied by a copy of the transmittal evidencing the mailing of the documents. The Petition has been accepted.

Information Disclosure Statement

Information Disclosure Statements filed 1/23/03 and 1/22/04 have been identified and the documents considered. The signed and initialed PTO Form 1449s has been mailed with this action.

Specification

The disclosure is objected to because of the following informalities: the application contains 3 sequence disclosures on page 54 that are described as SEQ ID NO; 13, 14, 17 15. The sequences appear to be SEQ ID NO:s 13, 14 and 15. Appropriate correction is required.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-11 are vague and indefinite in that the metes and bounds of "a sequence specific recombinase based system" are unclear. A "recombinase based system" is not defined in the specification. The recitation of "system" implies method steps that are not properly included in a product claim. Therefore, it is unclear if by "system" applicants intend to mean a living organism or a process for obtaining an objective or a combination of both which is non-statutory.

Claims 2-7, 9-11 and 21-28 are vague and indefinite in that the metes and bounds of "recombinase recognition sites" are unknown. Virtually any DNA can serve as "recombinase recognition sites". It appears from the specification that applicants intended to specify sequence specific recombinases. It would be remedial to amend claim language to clearly indicate what is intended by the limitation of "recombinase recognition sites".

Conclusion

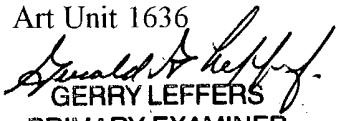
Claims 2-11 and 21-28 are rejected.

Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (571)-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maria B Marvich, PhD
Examiner
Art Unit 1636

GERRY LEFFERS
PRIMARY EXAMINER

November 29, 2004